

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

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|-------------------------------|---|-----------------------------|
| BAYER AG and |) | |
| BAYER CORPORATION, |) | |
| |) | |
| Plaintiffs, |) | |
| |) | |
| v. |) | Civil Action No. 01-148-SLR |
| |) | |
| HOUSEY PHARMACEUTICALS, INC., |) | |
| |) | |
| Defendant. |) | |

MEMORANDUM ORDER

I. INTRODUCTION

Plaintiffs Bayer AG and Bayer Corporation filed this action on March 6, 2001 seeking a declaratory judgment that four patents assigned to defendant Housey Pharmaceuticals, Inc. are invalid, unenforceable and not infringed. (D.I. 1) Defendant has filed a counterclaim of infringement. (D.I. 5) The court has jurisdiction over this action pursuant to 28 U.S.C. §§ 1331, 1338(a) and 2201(a). Currently before the court is defendant's motion to exclude the opinion testimony of John T. Goolkasian. (D.I. 215) For the following reasons, the court shall deny defendant's motion.

II. DISCUSSION

Defendant initially asserted four arguments in its opening brief as the basis for its motion to exclude the expert testimony of John T. Goolkasian. Following plaintiffs' answering brief, defendant's reply brief concedes the arguments have been reduced

to two: (a) Mr. Goolkasian should be precluded from testifying regarding those topics on which he states he "may" give an opinion in his expert report; and (b) opinions regarding pending applications are irrelevant.

As an initial matter, the court reminds both parties that they are required to follow Local Rule 7.1.1.¹ The rule is not intended to be a mere formality, but rather must be followed by the parties in good faith. Many of the issues raised by this motion appear to have been initially conceded by plaintiffs' counsel prior to defendant submitting this motion. (D.I. 221, Ex. B) Defendant finally recognized several of plaintiffs' concessions through briefing. Local Rule 7.1.1 prevents this occurrence. The court will address defendant's two remaining arguments.

A. Mr. Goolkasian Testimony Regarding Those Topics on Which He States He "May" Give an Opinion in His Expert Report

Defendant asserts its motion based, in part, on the concern that Mr. Goolkasian's expert report states several times that he "may" testify on various matters. Defendant argues this language merely identifies possible topics for testimony without setting

¹Local Rule 7.1.1 states, in relevant part, "[T]he Court will not entertain any non-dispositive motion . . . unless counsel for the moving party files with the Court . . . a statement showing that the attorney making the motion has made a reasonable effort to reach agreement with the opposing attorneys on the matters set forth in the motion."

forth what the testimony may be. Plaintiffs' brief states, "Bayer has no intention of going beyond Mr. Goolkasian's expert report and deposition testimony[.]" (D.I. 221 at 10)

Based on plaintiffs' concession, the court finds no basis to consider the motion at this time. Certainly, the court will not permit Mr. Goolkasian to testify beyond the scope of his expert report. See Fed. R. Civ. P. 26(a)(2)(B) ("The report shall contain a complete statement of all opinions to be expressed and the basis and reasons therefor[.]"); see also Guidelines: Legal Expert Testimony in Patent Cases, at <http://www.ded.uscourts.gov/SLRmain.htm> (outlining this court's guidelines regarding admissible expert testimony in a patent case).

B. Relevancy of Opinions Regarding Pending Applications

Defendant's other remaining concern is that Mr. Goolkasian intends to opine on the prosecution history of pending patent applications. Defendant argues this testimony is not relevant to the case at bar as these patents have not been asserted. Plaintiffs argue portions of the prosecution history of these pending applications are relevant to the invalidity and inequitable conduct charges.

The court finds that arguments based on the relevance of a portion of an expert's testimony are not an appropriate basis for a motion to exclude the expert's testimony in its entirety.

Arguments pertaining to the relevancy of a portion of Mr. Goolkasian's testimony are more appropriately raised as a motion in limine. Further, the court notes that because the inequitable conduct portion of the case will be tried before the court, the court will consider the admissibility of any expert testimony regarding inequitable conduct during the trial.

III. CONCLUSION

At Wilmington this 22nd day of October, 2002, having reviewed defendant's motion to exclude the opinion testimony of John T. Goolkasian and the papers submitted in connection therewith;

IT IS ORDERED that defendant's motion to exclude the opinion testimony of John T. Goolkasian (D.I. 215) is denied.

Sue L. Robinson
United States District Judge